

DETAILED ACTION

Status of Examination and Prosecution

Examination of the application has been transferred to another examiner in the same art unit. Please address future correspondence accordingly.

Receipt of Applicant's remarks filed on December 11, 2009 is acknowledged. All rejections not explicitly maintained in the instant office action have been withdrawn in response to Applicant's amendment. In particular, rejections over Guskey et al. have been withdrawn and the amendment to claim 55 is entered.

Status of Claims

Claims 46-75 are pending. Claim 46 recites:

46. A cosmetic formulation, wherein the formulation comprises a microemulsion which comprises (a) one or more antiperspirant active ingredients and (b) one or more α -hydroxycarboxylic acids which comprise mandelic acid.

Claims 47 – 63 depend directly or indirectly from claim 46.

Claim 64 recites:

64. A cosmetic formulation, wherein the formulation is transparent, is suitable for application to human skin, and comprises a microemulsion which comprises from 1% to 25% by weight, based on a total weight of the formulation, of (a) one or more antiperspirant active ingredients which comprise aluminum chlorohydrate, activated aluminum chlorohydrate, or both, and from 0.1% to 10% by weight, based on a total weight of the formulation, of (b) one or more α -hydroxycarboxylic acids which comprise mandelic acid.

Claims 65 – 75 depend directly or indirectly from claim 64.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 46, 48 and 54-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,942,871 (Brüning) in view of US 5,571,841 (Yu et al.) and US 2002/0102295 (Niemiec et al.). This is the same rejection as presented in the Office Action dated August 14, 2009.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Brüning et al. teach a microemulsion gel composition comprising aluminum zirconium salts in the amount of 5-40% by weight, an oil component, water component, and surfactants, Abstract; column 1, lines 63-67; column 2, lines 1-14; column 4, lines 60-67; column 7, lines 55-57; Table 1 in column 12; and claims 15-17.

Brúning et al. discloses a **transparent** antiperspirant. Abstract and column 2, lines 7-8. The microemulsion can contain **polyethoxylated and polypropoxylated emulsifiers**. Column 5, lines 29-37. The formulations may contain additional ingredients such as deodorants and **α-hydroxyacids** (e.g. citric acid, lactic acid, malic acid). Column 7, lines 63-67; column 9, lines 3-5 and lines 35-56.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Brúning et al. teach the incorporation α-hydroxycarboxylic acids but do not teach mandelic acid. Further, Brúning et al. do not teach the instantly claimed amount of the hydroxycarboxylic acid (i.e. 0.1 to 10% by weight). These deficiencies are cured by the teachings of Yu et al. and Niemiec et al.

Yu et al. teach compositions comprising α-hydroxycarboxylic acids for enhancing the therapeutic effects of topically applied agents. Abstract. Hydroxyacids are disclosed to enhance the therapeutic efficacy of cosmetic agents, such as antiperspirants, when applied topically to the skin. Column 2, lines 16-40. Examples of the hydroxycarboxylic acids include **mandelic acid**. Column 3, lines 11-21. The concentration of the hydroxyacids that can be incorporated into the cosmetic formulation ranges from **0.01 to 99% by weight of the formulation**. Column 6, lines 44-53. The compositions may be formulated into gels. Column 6, lines 64-67.

Niemiec et al. teach compositions for application to the skin and/or hair (see the abstract). The composition may further contain benefit agents. Page 6, paragraphs 80.

Examples of benefit agents include antioxidants, such as alpha hydroxyacids including **mandelic acid**. Page 7, paragraphs 87 and 88.

Finding of prima facie obviousness Rationale and Motivation

(MPEP 2142-2143)

One of ordinary skill in the art would have been motivated to incorporate mandelic acid into the microemulsion taught by Brűning et al. because it is already known in the art that antiperspirant microemulsions can contain antioxidants such as alpha hydroxyacids, as suggested by Brűning et al. It is known in the art that alpha hydroxyacid such as mandelic acid is an antioxidant known for use in topical cosmetic formulations, as suggested by Niemeic et al. Further, Yu et al. suggest that hydroxycarboxylic acids (e.g. mandelic acid) help enhance the efficacy of antiperspirants.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to incorporate mandelic acid into the microemulsion taught by Brűning et al. because it is an obvious variation of hydroxycarboxylic acids that will not only function as an antioxidant but also enhance the efficacy of the antiperspirant in the microemulsion formulation taught by Bruning et al.

Although Brűning et al. do not teach the amount of hydroxycarboxylic acid that is present in the formulation, it would have been obvious to one of ordinary skill in the art to incorporate mandelic acid in the amount instantly claimed (i.e. 0.01 to 10% by weight) because it is known to incorporate hydroxycarboxylic acids in antiperspirant cosmetic formulations in the about of 0.01 to 99% by weight, as suggested by Yu et al. Thus, it is

an obvious amount of hydroxycarboxylic acid that may be added to antiperspirant formulations.

With respect to claims 56- 57, it is noted that Br  ning et al. and Yu et al. do not specifically teach instantly claimed ratio of (a) antiperspirant to (b) hydroxycarboxylic acids (i.e. (a) to b) is from 15:1 to 1:1, or 10:1 to 2.5:1). However, Br  ning et al. teach the use of antiperspirant in the amount of 5-40% by weight and Yu et al. teach that hydroxyacids can be used to enhance active compounds such as antiperspirants, in the pharmaceutical formulations in an amount ranging from 0.01 to 99% by weight. Thus, the compounds can be used in amount that would encompass a 15:1 ratio or 1:1: ratio. For example, the antiperspirant composition can comprise 20% of antidepressant and 20% of mandelic acid. Thus, it would have been obvious for one of ordinary skill in the art to use the instant ingredients in the ratio instantly claimed. Further, It is merely routine optimization for one of ordinary skill in the art to vary the amount of antiperspirant and mandelic acid in the formulation depending on the desired properties of the formulation.

With respect to claims 61 and 62, i.e. "...wherein the formulation has a defined yield point." It is the Examiner's position that since the disclosures of the prior art references teach the combination of antiperspirants and hydroxyacids (i.e. mandelic acid), the limitation will implicitly occur when the instant components are combined together in the composition.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the reference, especially in the absence of evidence to the contrary.

Claims 47 and 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brűning et al. (of record) in view of Yu et al. (of record), Niemiec et al. (of record), and US 6,468,551 (Diec et al.). This is the same rejection as presented in the Office Action dated August 14, 2009.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Brűning et al. teach a microemulsion gel composition comprising aluminum zirconium salts in the amount of 5-40%, an oil component, water component, and surfactants (see the abstract, column 1 lines 63-67, column 2 lines 1-14, column 4 lines 60-67, column 7 lines 55-57, Table 1 in column 12, and claims 15-17). The formulation of the invention is transparent (see the abstract and column 2 lines 7-8). The microemulsion can contain polyethoxylated and polypropoxylated emulsifiers (see column 5 lines 29-37). The formulations may contain additional ingredients such as deodorants and α-hydroxyacids (e.g. citric acid, lactic acid, malic acid) (see column 7 lines 63-67 and column 9 lines 3-5 and lines 35-56).

Yu et al. teach compositions comprising hydroxycarboxylic acids for enhancing the therapeutic effects of topically applied agents (see the abstract).

Hydroxyacids are discovered to enhance the therapeutic efficacy of cosmetic agents, such as antiperspirants, when applied topically to the skin (see column 2 lines 16-40). Examples of the hydroxycarboxylic acids include mandelic acid, glycolic acid, lactic acid, etc. (see column 3 lines 11-21). The concentration of the hydroxyl acids that can be incorporated into the cosmetic formulation ranges from 0.01 to 99% by weight of the formulation (see column 6 lines 44-53). The formulations may be formulation into gels, lotion, stick, etc. (see column 6 lines 64-67).

Niemiec et al. teach compositions for application to the skin and/or hair (see the abstract). The composition may further contain benefit agents (see page 6 paragraphs 80). Examples of benefit agents include antioxidants, such as alpha hydroxyacids including mandelic acid, citric acid, glycolic acid, lactic acid, etc. (see page 7 paragraphs 87 and 88).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Brúning et al. teach a microemulsion antiperspirant gel comprising an oil component, water and emulsifiers. Diec et al. specifically teach an oil-in-water microemulsion which comprises an oil phase, a water phase and emulsifiers.

Diec et al. teach microemulsion gels based on the oil in water type, comprising an oil phase, substantially consisting of not easily volatile constituents, and an aqueous phase containing one or more O/W emulsifiers free from ethylene oxide and propylene oxide and possibly one or more additional O/W emulsifiers, an emulsifier content which is lower than 20 wt. % related to the full weight of the microemulsion (see the abstract,

Art Unit: 1616

column 7 lines 50-67 and column 8 lines 1-10). The microemulsion gel is obtained in such a way that a mixture of basic constituents, consisting of an aqueous phase, an oil phase, one or more O/W emulsifiers, possibly one or more additional O/W emulsifiers, additional or active agents, is made to react against each other in a mixing ratio so that a microemulsion can be obtained and in which droplets of discontinuous oil phase are bound to each other by one or more cross-linking substances, whose molecules are characterized by at least one hydrophilic area having a suitable expansion for bridging of distance between each microemulsion droplet and at least one hydrophobic area, which can interact hydrophobically with the microemulsion droplets(abstract, column 7 lines 50-67 and column 8 lines 1-10). It is advantageous to add W/O emulsifiers to the microemulsion gel (see column 23 lines 51-67). The microemulsion gels can be used as bases for cosmetic deodorant/antiperspirants (see column 26 lines 47-67 and column 27 lines 1-17). The microemulsion gels are stable and provide good skin tolerability (see column 4 lines 32).

Finding of prima facie obviousness Rationale and Motivation**(MPEP 2142-2143)**

One of ordinary skill in the art would have been motivated to make an oil-in-water microemulsion comprising an oil phase, water phase and an emulsifier because antiperspirant microemulsion gel comprising an oil phase, water phase and emulsifiers are known to be stable and provide good skin tolerability as suggested by Diec et al.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to prepare in the manner taught by Diec et al. for the purpose of providing stability to the composition and enhanced benefits to the and skin.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the reference, especially in the absence of evidence to the contrary.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 46, 54, 55-61, 63-64, and 72-74 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-57 of copending Application No. 10/574231, in view of Bruning et al. US Patent No. 6,942,871.

The instant claims are drawn to a cosmetic formulation comprising a microemulsion comprising (a) one or more antiperspirant active ingredients and (b) one or more α-hydroxycarboxylic acids which comprise mandelic acid.

Claims 34-57 of copending application No. 10/571231 are drawn to a cosmetic formulation comprising a microemulsion comprising (a) one or more antiperspirant active ingredients and (b) one or more α-hydroxycarboxylic acids which comprise mandelic acid.

Brúning et al. teach a microemulsion composition comprising aluminum zirconium salts in the amount of 5-40%, an oil component, water component, and surfactants (see the abstract, column 1 lines 63-67, column 2 lines 1-14, column 4 lines

60-67, column 7 lines 55-57, Table 1 in column 12, and claims 15-17). The formulation of the invention is transparent (see the abstract and column 2 lines 7-8). The microemulsion can contain polyethoxylated and polypropoxylated emulsifiers (see column 5 lines 29-37). The formulations may contain additional ingredients such as deodorants and α-hydroxyacids (e.g. citric acid, lactic acid, malic acid) (see column 7 lines 63-67 and column 9 lines 3-5 and lines 35-56). The microemulsion is useful in the production of antiperspirant gel and stick preparations (see column 1 lines 12-16 and 53-60).

Although the conflicting claims are not identical, they are not patentably distinct from each other because each invention is drawn to cosmetic formulations that comprise antiperspirants and mandelic acid. The instant claims differ from the copending claims by more narrowly defining the physical form of instant composition (i.e. microemulsion). However, it is known in the art that cosmetic antiperspirant formulations can be prepared in the form of a microemulsion, which is useful for the production of antiperspirant gels or sticks, as suggested by Bruning et al. Thus, it would have been obvious to one of ordinary skill in the art to prepare cosmetic formulations in the form of a microemulsion depending on the desired final form of the product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant has indicated that it is prepared to file a terminal disclaimer, but requests deferral of a response until allowable subject matter is identified. There is no

provision in the MPEP permitting Applicants to defer response to a rejection. Thus, **the rejection is maintained.**

New Rejections

Claims 46 – 52 and 54 - 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,942,871 (Brűning et al.) in combination with US 5,571,841 (Yu et al.).

Determination of the scope and content of the prior art

(MPEP 2141.01)

The disclosure of Brűning et al. is presented above. In addition, the reference teaches **1-40 wt % surfactant/emulsifier, 10-50 wt. % oil, and water**. Column 7, lines 47 -63. Brűning et al. discloses a wide variety of surfactants having a range of properties suitable for various types of emulsions. Column 2, line 15 to column 3, line 67. More specifically, the reference discloses surfactants can be **ethoxylated sorbitan esters, such as fatty acid ethoxylates**. Column 2, lines 28-34. The surfactants can be **sugar alcohols with stearic acid fatty acid tails**, i.e. glyceryl stearate. Column 2, lines 19 – 25. Also, Brűning et al. exemplifies glyceryl oleate in a composition with aluminum chlorohydrate. See Table I. Glyceryl oleate is structurally and functionally similar to glyceryl stearate. The reference further discloses **polyethoxylated lanolin** and lecithin derivatives, i.e. **emulsifiers**. Column 8, lines 42 – 46. Brűning et al. discloses that **the antiperspirant can be 5-40 wt. %**. Column 7, esp. line 56-57. More specifically, the reference discloses **20 wt. % aluminum chlorohydrate**. See Table I.

The disclosure of Yu et al. is provided above.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Brüning et al. teach microemulsion antiperspirants having aluminum salts and the incorporation α -hydroxycarboxylic acids, but do not specifically teach the α -hydroxycarboxylic acid mandelic acid. Also, Brüning et al. do not teach the instantly claimed amount of the hydroxycarboxylic acid (i.e. 0.1 to 10 wt. %). These deficiencies are cured by the teachings of Yu et al.

Finding of prima facie obviousness Rationale and Motivation

(MPEP 2142-2143)

One of ordinary skill in the art at the time of the invention would have found it obvious, upon reading Brüning et al., to turn to the disclosure of Yu et al. for additional information on the usefulness of α -hydroxyacids, because Brüning et al. disclose a few such acids. Moreover, Yu et al. provides a broadly applicable composition and method for enhancing therapeutic effects of topically applied antiperspirants. Thus, the skilled artisan would seek to apply the benefits conferred by Yu et al.'s agents to other antiperspirant formulations such as are provided by Brüning et al. Furthermore, Yu et al. specifically recites that other specific forms may be used without departing from the spirit or essential characteristics of the patent. Column 20, lines 1-3. This recitation supports a motivation to combine.

A few claims deserve additional comments.

Claims 47, 49 – 53, 65, and 67 – 71 are limited to oil-in water or water-in-oil microemulsions or emulsifiers. The Examiner takes the position that it would have been entirely routine for the skilled artisan to prepare oil-in water and/or water-in-oil microemulsions from the rich disclosure of O/W and W/O emulsifiers provided by Brűning et al.

Claims 61, 62, 74, and 75 require a defined yield point. Examiner asserts that microemulsions having the same composition necessarily have a defined yield point and that the yield point would be the same as claimed.

With regard to claim 71, the disclosure of Brűning et al. identifies sugar alcohol stearates and exemplifies glyceryl oleate. It would have obvious to the skilled artisan to try the closely related surfactant glyceryl stearate, because the properties of the class are similar and the differences are suitable for optimizing the microemulsion composition.

Claims 47, 49 – 53, 65, and 67 - 71 are rejected as obvious over Brűning et al. (of record) in combination with Yu et al. (of record) further in combination with Diec et al. (of record).

Determination of the scope and content of the prior art

(MPEP 2141.01)

The disclosures of Brűning et al. and of Yu et al. are presented above, especially under “New Rejections.” The disclosure of Diec et al., e.g. as directed to microemulsion antiperspirants, is also presented above. In particular, Diec et al.

discloses that the microemulsion can be of the oil-in-water type and can also have one or more water-in-oil emulsifiers. Column 7, line 50 – column 8, line 10. Diec et al. further discloses that droplets of the discontinuous oily phase are joined to one another by one or more crosslinking substances, the molecules of which are distinguished by at least one hydrophilic region, which has an extension which is suitable for bridging the distance between the microemulsion droplets and by at least one hydrophobic region, which is capable of entering into a hydrophobic interaction with the microemulsion droplets.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

The teachings of Brűning et al. and Yu et al. are discussed above. Diec et al. explicitly teach the elements of the claims 47, 49 – 53, 65, and 67 – 71 that are missing in Brűning et al. and of Yu et al., as recited above.

Finding of prima facie obviousness Rationale and Motivation

(MPEP 2142-2143)

One of ordinary skill in the art at the time of the invention would have found it obvious, upon reading Brűning et al. and Yu et al., to turn to the disclosure of Diec et al. for the reasons provided above and for additional information on variations for preparing microemulsion antiperspirants, because all three references are directed to antiperspirants. Moreover, Diec et al., like Brűning et al., is directed to microemulsions.

Response to Arguments and Comments on Remarks

Arguments in Response to Rejections over Brűning et al. as Primary Reference

In the Amendment dated December 11, 2009, after some introductory remarks, Applicant argues that Yu et al. fail to provide an apparent reason for one of ordinary skill in the art to use mandelic acid as an antioxidant and/or as an agent for enhancing the efficacy of the antiperspirants of Brűning et al. Amendment of December 11, 2009 at page 11, line 22 to page 12, line 3.

Examiner respectfully draws Applicant's attention again to the disclosure found in Yu et al. Yu et al. states: "[H]ydroxyacids ... enhance the therapeutic efficacy of cosmetic and pharmaceutical agents in topical treatment of cosmetic conditions, dermatological disorders or other afflictions. ... Some examples of cosmetic and pharmaceutical agents include ... antiperspirants" Column 2, lines 16 to 40. Thus, Yu et al. has established the general basis that hydroxyacids enhance the efficacy of topical cosmetic agents. Yu et al. continue by disclosing the genus of hydroxycarboxylic acids that they have found useful. Column 2, lines 41 to 54. Moreover, Yu et al. specifically disclose mandelic acid by common name, by systematic name, and by formula. Column 3, line 10 to column 4, line 9, esp. column 3, lines 20-21. Thus, a straightforward reading of Yu et al.'s disclosure reveals that mandelic acid is an agent that enhances the efficacy of antiperspirants. For at least this reason, Applicant's argument fails.

Applicant next remarks that (while assuming motivation to incorporate an α-hydroxyacid into the preparations of Brűning et al., *at* page 11, esp. lines 22-24)

antiperspirants are only one of a host of most diverse examples of cosmetic and dermatological agents that Yu et al. mention. *Amendment at page 12, lines 4 – 9.*

Applicant's remark fails to reflect that the primary reference is Brűning et al., which is directed to antiperspirants. Thus, the question of obviousness is whether one of ordinary skill in the art at the time of the invention, upon reading Brűning et al. would have found it obvious to turn to another reference also directed to antiperspirants for additional guidance on improving the formulation. That is, of course, is exactly what those of skill in the art routinely do. Thus, Applicant's remark is not persuasive.

Applicant further remarks that none of Yu et al.'s examples are directed to antiperspirants. *At page 12, line 10.*

The remark does not rise to the level of an argument. Even if construed as an argument for patentability, it fails for the reason provided above.

Applicant further notes that *the claims* of Yu et al. do not recite the use of mandelic acid as an agent for enhancing the efficacy of any cosmetic or pharmaceutical agent in topical treatment of cosmetic conditions, dermatological disorders or other afflictions, but are drawn merely to the use of mandelic acid for visibly reducing a human wrinkle. *At page 12, lines 11—18.* Applicant argues on this basis that mandelic acid does not belong to the hydroxyacids which are of value for enhancing the efficacy of any cosmetic or pharmaceutical agent, let alone of an antiperspirant. *Id. at lines 18 - 21.*

Examiner fears that Applicant has misconstrued the claims of Yu et al., which clearly recite a method using a composition *comprising* mandelic acid ... According to

the rules of US patent claim construction, the composition claimed by Yu et al. can have constituent(s) in addition to mandelic acid. Moreover, issued claims reflect only what was new and non-obvious in the art at the time of the invention and of particular commercial value to the Applicant, so that information or constituents that are lacking in a claim are not dispositive of the disclosure.

Applicant further remarks that Yu et al. mentions more than 50 specific examples of hydroxyacids and that one of Yu et al.'s lists of hydroxyacids does not recite mandelic acid. At page 12, line 22 to page 13, line 2. On the notes above and this additional basis Applicant argues that only with hindsight in view of the disclosure of Yu et al. would one of ordinary skill in the art have picked mandelic acid as an agent for enhancing the efficacy of the antiperspirants of Brüning et al.

On the contrary, Examiner notes that one of ordinary skill in the art would have found it obvious to improve the formulation of Brüning et al. by turning to Yu et al. precisely because Yu et al. disclose that antiperspirants can be improved by adding an α-hydroxyacid and specifically discloses mandelic acid. Indeed, as Applicant so kindly pointed out, Yu et al. highlight the use of mandelic acid in their claims. Thus, one of ordinary skill in the art, upon perusing the lists of hydroxyacids could also have noticed that mandelic acid was singled out by Yu et al. for enhancing a therapeutic or cosmetic effect.

Moreover, hindsight reasoning is not a basis for refuting a rejection, rather the standard is *improper* hindsight reasoning. That is, the reasoning must take into account only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and not include knowledge gleaned only from the applicant's disclosure. See *In re McLaughlin*, 443 F.23 1392, 170 USPQ 209, 212 (CCPA 1971). Therefore, Applicant's argument is not persuasive.

Applicant also argues that the α -hydroxyacids specifically mentioned in Brűning et al. are aliphatic acids, whereas mandelic acid is an aromatic acid.

The basis of the rejection is obviousness, not anticipation as it might have been if Brűning et al. disclosed mandelic acid. Rather, the rejection relies upon Yu et al. for disclosure than mandelic acid provides an enhancement of antiperspirant effectiveness. Thus, Applicant's argument is misdirected and without foundation.

Applicant further comments that citric acid, lactic acid, and malic acid, but not mandelic acid, are disclosed in one or more examples in Yu et al. At page 13, line 21 to page 14, line 2.

In this instance, Applicant is arguing how much emphasis the reference provides various non-claimed acids. Whether acids that are not claimed in the instant application are, or are not, mentioned in the reference is not relevant to the soundness of the rejection.

With regard to claims 56 and 57, Applicant argues that the basis of motivation to make a specific formulation is unclear. At page 14, lines 3 – 6.

Examiner kindly refers Applicant to the Office Action of August 14, 2009, page 6, line 22 to page 7, line 12 and the corresponding section above. In particular Examiner Brooks provided two rationales for motivation to make compositions with the claimed antiperspirant to mandelic acid ratios. First, Brűning et al. teach compositions having 5-

40 wt. % antiperspirant and Yu et al. teach antiperspirants having 0.01 – 99 wt. % α-hydroxyacids. Thus, the ratio of these ranges encompasses the claimed ranges. The second argument that the Examiner made is that it would have been routine for one of ordinary skill in the art to have optimized the ratio of antiperspirant and mandelic acid in the formulation to achieve the desired properties of the formulation. These reasons properly establish a *prima facie* case of obviousness for claims 56 and 57.

Applicant asserts that none of the documents cited by the Examiner appears to disclose any specific composition which comprises both an antiperspirant and an α-hydroxycarboxylic acid. At page 14, lines 16 – 19.

Applicant has unfortunately conflated an anticipation rejection and an obviousness rejection. The argument is not persuasive.

With regard to claim 55, Applicant argues that Brűning et al. teaches away from an antiperspirant composition comprising aluminum chlorohydrate because an example of such a composition has a viscosity lower than the antiperspirant compositions claimed by Brűning et al. which must comprise aluminum-zirconium salts. At page 15, lines 4 – 15. Although Applicant does not cite the case, it appears to rely on *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* for this argument. 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986) (A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered.)

First, Brűning et al. is not relied on for its disclosure of aluminum-zirconium antiperspirants but for its disclosure of microemulsion gel compositions, antiperspirants including aluminum chlorohydrate and other components. See, e.g. the Office Action of

August 14, 2009, page 4, lines 7—11, esp. the reference to Table 1, and corresponding sections above. Second, Brűning et al. is not relied on for what it claims but for what it discloses. Next, a reference can be relied on for what it disparages. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). (“[A] prior art reference is relevant for all that it teaches to those of ordinary skill in the art.”) Next, Applicant is arguing a feature not claimed in the instant application. *Bausch & Lomb, Inc.* does not govern here because Brűning et al. does not state that antiperspirants having aluminum chlorohydrate are unworkable, merely that they are less suitable for Brűning et al.’s high-viscosity invention. Thus, it is not a *bona fide* teaching away. Also, the instant independent claims are not limited to high viscosity compositions.

Thus, Examiner Brooks has properly established a *prima facie* case of obviousness based on the disclosure of Brűning et al., Yu et al., Niemic et al., and optionally Diec et al. The **rejection is maintained** because Applicant has not successfully rebutted the *prima facie* case and has provided no evidence of secondary considerations.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOR B. NIELSEN whose telephone number is (571)270-3476. The examiner can normally be reached on Monday through Friday from 9:00 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thor Nielsen
Patent Examiner
AU 1616

/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616